



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/626,142

07/24/2003

Paul A. Burgio

58359US003

9324

32692

7590

06/06/2008

3M INNOVATIVE PROPERTIES COMPANY

PO BOX 33427

ST. PAUL, MN 55133-3427

EXAMINER

SUTTON, DARRYL C

ART UNIT

PAPER NUMBER

1612

NOTIFICATION DATE

DELIVERY MODE

06/06/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

LegalDocketing@mmm.com

Office Action Summary	Application No. 10/626,142	Applicant(s) BURGIO ET AL.	
	Examiner DARRYL C. SUTTON	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-17,19-25,27-32,34-43 and 45-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-17,19-25,27-32,34-43 and 45-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the amendment filed 1/04/2008. No new claims have been added.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Applicant's arguments filed 09/21/2007 have been fully considered. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

Response to Applicant's Arguments

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 8-11, 14-17, 19, 22, 30-32, 34, 36-43, 45-64 and 69-80 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mitra et al. (U.S. Patent 5,888,491) in view of Majeti et al. (U.S. Patent 7,025,950).

The rejection is maintained.

The applicant argues that the primary reference (5,888,491) does not disclose the limitation that the polymer includes "a repeating unit comprising a fluoride releasing group" and that "the repeating unit comprising the polar or polarizable group is different than the repeating unit comprising the fluoride releasing group". However, the prior art does teach that the polymer has repeating units of A, B and C; and A units may be derived from monomers with a fluoride counterion, i.e. fluoride releasing groups (column 3, lines 35-43, column 4, lines 41-58). Polar or polarizable groups include neutral groups, such as hydroxy (column 3, lines 48-58). Unit B monomers include branched or cyclic alcohols, i.e. compounds with a polar or polarizable hydroxy group (column 5, lines 16-20). The two repeating units, A and B, are different; and unit A is comprised of a fluoride releasing group, and unit B is comprised of polar or polarizable hydroxy group.

Claims 6, 7, 12, 13, 20, 21, 23-25, 27-29 and 65-68 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mitra et al. (U.S. Patent 5,888,491) in view of Majeti et al. (U.S. Patent 7,025,950), the combination being taken in further view of Aasen et al. (U.S. 4,871,786).

The rejection is maintained.

The response to applicant arguments concerning Mitra et al. and Majeti et al. are discussed above. Aasen et al. provides motivation for combining the Mitra et al. and Majeti et al. references with Aasen et al. for the 103(a) rejection, as previously discussed.

Claims 30-32, 34, 35, 37-43, 45, 50-52 and 60-68 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rozzi et al. (U.S. Patent 5,607,663) in view of Majeti et al. (U.S. Patent 7,025,950).

The rejection is maintained.

The applicant argues that the primary reference (5,607,663) does not disclose the limitation that the polymer includes "a repeating unit comprising a fluoride releasing group" and that "the repeating unit comprising the polar or polarizable group is different than the repeating unit comprising the fluoride releasing group". However, the prior art does teach that the polymer has repeating units of A, B and C; and A units may be derived from monomers with a fluoride counterion, i.e. fluoride releasing groups (column 2, lines 55-63, column 3, lines 59-67, column 4, lines 1-8). The polar or polarizable groups include neutral groups, such as hydroxy (column 3, lines 1-5). Unit B monomers include branched or cyclic alcohols, i.e. compound with a polar or polarizable hydroxy group (column 4, lines 35-40). The two repeating units, A and B, are different; and unit A is comprised of a fluoride releasing group, and unit B is comprised of polar or polarizable hydroxy group.

No claims are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darryl C. Sutton whose telephone number is

Art Unit: 1612

(571)270-3286. The examiner can normally be reached on M-Th from 7:30AM to 5:00PM EST or on Fr from 7:30AM to 4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass, can be reached at (571)272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Darryl C Sutton/
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612